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EXAMINER

CHANG, KENT WU

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2629

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/932,213
Filing Date: August 17, 2001
Appellant(s): WEBB ET AL.

Zurvan Mahamedi
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/16/07 appealing from the Office action
mailed 3/13/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boesen (US Patent No. 5,542,721).

Boesen discloses a mobile device having a first segment; a second segment with a first input feature (keypad section 22) moveably coupled to the first segment to move between a contracted position having a reduced length (as shown in Fig.9) and an extended position having a maximum length (as shown in Fig.7) along one axis; a display assembly provided by the first segment, wherein the portion of the display assembly is accessible to contact by a user when the second segment is in the

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extended position; wherein the second segment overlays the first segment when the second segment is in the contracted position so as to reduce a length of the mobile device as recited in claims 1, 19-21, 27-29, 41, 45-50 (see column 5 lines 23-40 and Figure 7). Obviously, the portion of the first segment being overlaid by the second segment could have varied from none to full length dependent on user's choice, a longer overlaid portion would have lead to a smaller size of the device, while a shorter overlaid portion would have provided more input functions to the user. Furthermore, Boesen includes a pivotable mechanism to allow the user to adjust the angle between the first segment and second segment. However, this function is only for enabling the user to use the device in a manner as a phone handset, and the pivoting operation is performed after the sliding operation, wherein the pivotable mechanism is operative independently from the operation of the sliding operation. It would have been obvious for one ordinary skill in the art at the time of the invention to operate the device without the pivoting motion since it merely depends on the user's preference on the angle and length of the device.

Consider claims 2 and 23. It would have been obvious for one of ordinary skill in the art at the time of the invention to replace the touch screen 38 with a small touch screen and a touch pad so as reduce manufacturing cost of the device. However, such a modification would have resulted to a touch screen with a small size.

Consider claims 3 and 22. The device of Boesen includes character recognition (column 4 lines 53-57).

Consider claim 4. The second segment in the device of Boesen includes a plurality of buttons (22) overlaying the portion of the display assembly.

Consider claims 5-7. Boesen further teaches to provide additional function buttons or other inputs (column 3 lines 51-55). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to modify Boesen's device to include other known input functions such as multi-directional member, touch pad as suggested by Boesen so as to provide the user additional input functions.

The device of Boesen includes a front shell (portion of 4), a midframe (portion of 38), a bottom shell (portion of 24), a first rail and a second rail, a first connecting member and a second connecting member to enable the second segment slide to the first segment (see figures 6 and 7). It would have been obvious for one of ordinary skill in the art at the time of the invention to housing the rails and connecting members in two side surface, the back surface, or other places of the mobile device since the device would function equally well with the rails and connecting members locating in any places (as recited in claims 8-18, 24-26, 30-37, 40). Furthermore, it would have been obvious for one of ordinary skill in the art at the time of the invention to use additional rails (as recited in claim 38-39) in the device of Boesen so as to enable easy moving of the two segments.

Consider claims 41, 42. Boesen discloses a mobile device having a first segment with a first input feature (the touch panel section 38), a second segment with a second input feature (keypad section 22) moveably coupled to the first segment to move between a contracted position having a reduced length (as shown in Fig.9) and an

extended position having a maximum length (as shown in Fig.7) along one axis; a display assembly provided by the first segment', wherein the second segment overlays a portion of the first segment when the second segment is in the contracted position so as to reduce a length of the mobile device (see column 5 lines 23-40 and Figure 7).

Furthermore, Boesen includes a pivotable mechanism to allow the user to adjust the angle between the first segment and second segment. However, this function is only for enabling the user to use the device in a manner as a phone handset, and the pivoting operation is performed after the sliding operation, wherein the pivotable mechanism is operative independently from the operation of the sliding operation. It would have been obvious for one ordinary skill in the art at the time of the invention to operate the device without the pivoting motion since it merely depends on the user's preference on the angle and length of the device.

Consider claim 43. The second segment has a plurality of buttons (22).

Consider claim 44. In one of the embodiment (as shown in Fig.8), Boesen further teaches that the first segment having a reduced section (28) that has a lesser thickness than the remainder of the first portion (24) so as to allow a portion of the first segment being easily accessible from the same surface level as the second surface level while in the contacted position, but still having the advantage of a reduce the length of the mobile device. Obviously, the portion of the first segment being overlaid by the second segment could have varied from none to full length dependent on user's choice, a longer overlaid portion would have lead to a smaller size of the device, while a shorter overlaid portion would have provided more input functions to the user.

(10) Response to Argument

Appellant's agrees with the examiner in that the device of Boesen (6,542,721) comprises two segments, the first segment (cellular transceiver portion 4 as shown in Figure 7) and the second segment (PDA portion 38), movable between a contracted position and an extended position, but alleges that the only way to achieve the extended position is by pivoting first segment. Appellant relies on Figures 7 and 10 of Boesen for supporting his position.

In response, the examiner indicates that Boesen teaches numerous embodiments to enable the opening and closing of the two segments, as illustrated in Figures 5-15, wherein the structure and operation are completely different in these embodiments. As illustrated in Figure 7, the PDA portion (38) is housed inside of the cellular transceiver portion (4) while in the contracted position, and can be moved out to an extended position **by sliding movement only**, then can be pivoted to allow the user to adjust the angle between the cellular transceiver portion and the PDA portion (note that a portion of the slide hinge 41 is inside of the cellular transceiver portion as shown by the dotted lines in Figure 7). However, the sliding movement can be performed without the pivoting movement if the user is willing to use the phone without adjusting the angle. The pivoting movement is

independent of the sliding movement and can only be performed after the PDA portion has completely moved out to the extended position since **pivoting the hinge or the cellular transceiver portion would be inhibited by the PDA portion before the PDA portion has completely moved out to the extended position.** In fact, the structure and operation of the device of Boesen as shown in Figure 7 are very similar to that of the instant application, wherein the second segment fits inside the first segment so that they slide along one axis without pivoting when moving between the contracted and extended position.

The structure and operation of the device as shown in Fig.7 is completely different from the one shown in Fig. 10 (as shown in Fig. 7, the cellular transceiver portion is thicker than the PDA portion, allowing the PDA portion to house inside the cellular transceiver portion; in Fig. 10, the cellular transceiver portion is thinner than the PDA portion, allowing the PDA portion to house above the cellular transceiver portion). Therefore, appellant's arguments relying on Fig.10 (page 6 of the Brief) are found unpersuasive. In addition, appellant's assertion that the term "slide" is only for modifying "hinge" (see the 4th paragraph on page 6 of the Brief) is also found unsupportive and unpersuasive since Fig.7 of Boesen clearly shows a slide hinge having sliding function independent of pivoting function.

As to applicant's arguments with respect to the limitation of the use of a pivotable mechanism, note that Boesen includes a pivotable mechanism to allow the user to adjust the angle between the first segment and second segment. However, this function is **only for enabling the user to use the device in a manner as a phone handset, and the pivoting operation is performed after the sliding operation, wherein the pivotable mechanism is operative independently from the operation of the sliding operation.** It would have been obvious for one ordinary skill in the art at the time of the invention to operate without the pivoting motion since it merely depends on the user's preference on the angle and length of the device.

As to appellant's arguments regarding claims 19-50, note that Boesen teaches that the second segment moveably coupled to the first segment between a contracted position having a reduced length (or minimum length) and an extended position having a maximum length (as shown in Fig.7) along one axis.

The remainder of the pertinent topics for argument are present in the appropriate rejections above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Kent Chang

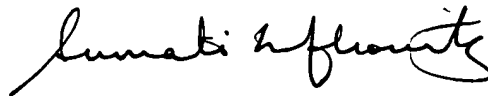


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